

Notice of Allowability

Applicati n No.

10/606,342

Examin r

Amelia A. Owens

Applicant(s)

WANG ET AL.

Art Unit

1625

-- The MAILING DATE f this communicati n appears on the cover sheet with the correspondenc address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/6/2006.
2. ☒ The allowed claim(s) is/are 20,21,23-28 and 30-72.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input checked="" type="checkbox"/> Other <u>DRAWINGS ACCEPTED</u> . |

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

1. Claims 73-80 have been canceled.

Applicant is reminded that upon the cancellation of claims, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 20,21,23-28,30-72 are pending and are allowed.

2. The rejection of claims 30-37,75,76 under 35 USC 112, 1st paragraph is dropped as the claims have been amended and/or canceled.
3. The rejection of claims 38-49,77-80 under 35 USC 112, 2nd paragraph is dropped as the claims have been amended and/or canceled.
4. The objection to claims 73-80 is dropped as the claims have been canceled.
5. The prior art neither teaches nor suggests the claimed compositions and method of use.

In the absence of any evidence or apparent reason why the claimed compounds do not possess the disclosed utility, the allegation of utility in the specification must be accepted as correct. In re Kamal et al, 158 USPQ 320; Ex parte Krenzer, 199 USPQ 227.

Further, the state of the art is that inhibiting retroviral replication and inhibiting a protease of a retrovirus are known. See Lori et al, Hydroxyurea : mechanisms of HIV-1 inhibition, PMID 10723506; Tomasselli et al, Targeting the HIV-protease in AIDS therapy; a current clinical perspective, Biochimica et Biophysica Acta 1477 (2000) 189-214.

There is no absolute statutory requirement for a working example if the disclosure is such that one skilled in the art can practice the claimed invention. In re Borkowski et al, 164 USPQ 642. Since 35 USC 112 does not demand a 'working example', an application cannot be fatally defective merely because it lacks one. In re Bartholome et al, 156 USPQ 20. Use of prophetic examples does not automatically make a patent non-enabling merely because there can be no guarantee that the examples would actually work. Atlas Powder Co. v E.I. DuPont de Nemours & Co., 224 USPQ 409.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'A. Owens', is positioned above the printed name.

Amelia A. Owens
Primary Examiner
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